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36335 7590 10/17/2013 GE HEALTHCARE, INC. IP DEPARTMENT 101 CARNEGIE CENTER PRINCETON, NJ 08540-6231			EXAMINER PARADISO, JOHN ROGER	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KENNETH BOLAM

Appeal 2011-012899
Application 10/279,042
Technology Center 3700

Before GAY ANN SPAHN, JOHN W. MORRISON, and
MICHELLE R. OSINSKI, *Administrative Patent Judges*.

OSINSKI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ appeals under 35 U.S.C. § 134(a) from a final rejection of claims 9, 11, and 14 under 35 U.S.C. § 103(a) as unpatentable over Deaton (US 6,128,918, iss. Oct. 10, 2000) and Niedospial (US 6,179,822 B1, iss. Jan. 30, 2001). Ans. 5. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

CLAIMED SUBJECT MATTER

Claims 9 and 14 are the independent claims on appeal. Claim 9 is illustrative of the appealed subject matter and is reproduced below:

9. A method for preparing an expandable storage container for receiving a quantity of hyperpolarizable gas, comprising the steps of:

forming a container cavity between a first and second container sheet;

forming a perimetrical seal about said container cavity by joining the overlying perimetrical edges of said first and second container sheets together so as to define a fill port at a gap in said perimetrical seal where said edges are not sealed;

providing a quantity of purge gas into the hyperpolarizable gas container through said fill port;

expanding the hyperpolarized gas container cavity by directing a quantity of purge gas therein;

collapsing the hyperpolarized gas container cavity by removing purge gas therefrom;

filling said container cavity with a hyperpolarizable gas mixture; and

sealing said perimetrical edges together across said fill port so as to provide a sealed container cavity holding said hyperpolarizable gas mixture.

¹ Appellant identifies the real party in interest as “Amersham plc (now GE Healthcare Limited, a part of General Electric Company).” Br. 1.

ANALYSIS

The Examiner's rejection is predicated on the finding that Niedospial discloses the recited step of "sealing said perimetrical edges together across said fill port" (Br., Claims App'x.), because "the edges on the perimeter of each web of the bag . . . [go from] not touching each other . . . [to] touching and in contact with the tube, which is in contact and touching the opposing sidewall, thus making the sidewalls and the tube an integral artifact at that point." Ans. 6.

Appellant contends that a "tube through the bottom seam of the Deaton container will prevent the perimetrical edges from being 'sealed together' across the fill-port/gap as is recited in the pending claims." Br. 7-8. In essence, Appellant contends that a "tube . . . holding the edges apart is in direct contravention of the claim limitation that the edges be joined 'together.'" *Id.* at 8.

The Specification does not assign or suggest a particular definition to the claim phrase "sealing . . . together" and therefore, it is appropriate to consult a general dictionary definition of the words for guidance in determining the ordinary and customary meaning of the claim phrase as viewed by a person of ordinary skill in the art. *See Comaper Corp. v. Antec, Inc.*, 596 F.3d 1343, 1348 (Fed. Cir. 2010). The ordinary and customary meaning of the claim term "seal" is "to keep shut, enclosed, or confined," and the ordinary and customary meaning of the claim term "together" is "in or into contact (as connection, collision, or union)." WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY, UNABRIDGED, Merriam-Webster, Incorporated, Copyright 1993, accessed at <http://lionreference.chadwyck>.

com (last visited Oct. 4, 2013). Thus, one of ordinary skill in the art would understand the claims to call for keeping the perimetrical edges enclosed by maintaining contact with each other. We find nothing in the Specification inconsistent with the ordinary and customary meanings described above. *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989) (the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification). Appellant's Specification describes that "the overlying edges [of sheet 112] are welded together so as to form a partial perimetrical seam 118" (Spec. 6, ll. 11-12) and that "[w]hile maintaining a fluid tight engagement about inlet port 125, seam 118 is completed across passageway 130 so as to isolate cavity 120 from the outside environment" (Spec. 7, ll. 1-3).

In light of this claim construction, Appellant's argument that Niedospial fails to disclose the recited step of "sealing said perimetrical edges together across said fill port so as to provide a sealed container cavity" is persuasive because Niedospial's edges are never kept enclosed by being in contact with each other at the fluid exit port or tube 14. Rather, Niedospial's fluid exit port or tube 14 extends between the edges of the sidewalls such that the sidewalls are never in contact with each other at the fluid exit port or tube 14.

Accordingly, Niedospial fails to disclose "sealing said perimetrical edges together" across said fill port or gap in the perimetrical seal as required by independent claims 9 or 14. *See Br.*, Claims App'x. The Examiner's conclusion of obviousness is thus based on an erroneous finding as to the scope and content of Niedospial.

Moreover, the Examiner's rejection acknowledged that Deaton fails to disclose an inlet port positioned at the perimeter seal of the bag. Ans. 5. To cure the deficiency of Deaton, the Examiner turned to Niedospial's disclosure of "an inlet port (16) place[d] at the perimeter seal of the bag sidewalls." *Id.* (citing Niedospial, fig. 1). The Examiner concluded that it would have been obvious to one of ordinary skill in the art "to form the bag of D[eaton] . . . with the inlet port at the perimeter seal, as taught by N[iedospial] . . . in order to provide for increased efficiency of emptying the bag when hung." *Id.*

Appellant argues that a person of ordinary skill in the art would have no reason to modify Deaton with the inlet port at the perimeter seal as taught by Niedospial since the Deaton bag with "the connector . . . at the center of one planar face, [already] allows for the opposing sheets to be brought fully together," whereas Niedospial's bag would not allow the opposed sheets of the container to be brought together because of "the provision of a relatively rigid tube at a bottom seam of the container." Br. 7. Therefore, Appellant contends that modification of Deaton's bag with the inlet port at the perimeter seal as taught by Niedospial would not provide for more efficient emptying of the bag as asserted by the Examiner. *Id.* Since Deaton's device already appears to accomplish efficient emptying of the bag and, moreover, it is unclear if Niedospial's teachings would actually improve emptying of the gas from the bag, the Examiner's rejection does not sufficiently explain what in the prior art would have prompted a person of ordinary skill in the art to modify Deaton's bag to include an inlet port at the perimeter seal. Thus, we are not persuaded that the Examiner's articulated reasoning has rational underpinnings (*see KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418

(2007) (holding that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness).

For the foregoing reasons, Appellant has shown the Examiner erred in concluding that the subject matter of independent claims 9 and 14 would have been obvious from the combination of Deaton and Niedospial, and we do not sustain the rejection of independent claims 9 and 14, and claim 11 which depends from claim 9, under 35 U.S.C. § 103(a) as unpatentable over Deaton and Niedospial.

DECISION

The Examiner’s rejection of claims 9, 11, and 14 under 35 U.S.C. § 103(a) is REVERSED.

REVERSED

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